

DOUGLAS E. LUMISH, Bar No. 183863  
doug.lumish@lw.com  
RICHARD G. FRENKEL, Bar No. 204133  
rick.frenkel@lw.com  
JEFFREY G. HOMRIG, Bar No. 215890  
Jeff.homrig@lw.com  
NICHOLAS YU, Bar No. 298769  
nicholas.yu@lw.com  
LATHAM & WATKINS LLP  
140 Scott Drive  
Menlo Park, CA 94025  
Tel: 650.328.4600  
Fax: 650.463.2600  
Counsel for Defendant  
AMAZON.COM, INC.  
[additional counsel listed on signature page]

**UNITED STATES DISTRICT COURT**  
**NORTHERN DISTRICT OF CALIFORNIA**  
**SAN FRANCISCO DIVISION**

EOLAS TECHNOLOGIES INCORPORATED,

Plaintiff,

v.

AMAZON.COM, INC.,

Defendant.

Case No: 3:17-cv-03022-JST(JSC)

**AMAZON'S STATEMENT OF OBJECTION TO POTENTIAL PREMATURE CONSIDERATION OF MERITS**

1 In the Court’s December 21, 2017 Order re: *In Camera* Review for Violation of Patent  
 2 Prosecution Bar (Dkt. # 414), the Court requires that the parties appear on February 1, 2018<sup>1</sup> and  
 3 be prepared to “discuss the possible remedy if the Court were to conclude that there was a violation  
 4 of the patent prosecution bar for the pre-July 22, 2014 time period, post-July 22, 2014 time period,  
 5 or both.” Amazon will, of course, be prepared to discuss these issues in general, but notes that  
 6 Judge Tigar’s September 27, 2017 Order Re Alleged Prosecution Bar Violation (Dkt. # 403) sets  
 7 forth a schedule for discovery commencing after the resolution of the production and privilege  
 8 disputes currently before the Court, and only after that discovery is complete orders that “the par-  
 9 ties will file a proposed briefing and hearing schedule (or if necessary, competing schedules) for  
 10 briefing remedies, including dismissal and/or judgment.” (*Id.* at ¶10.) Accordingly, Amazon re-  
 11 spectfully provides notice it objects to the extent that the Court intends to reach the merits of Am-  
 12 azon’s pending motion regarding Eolas’s violation of the prosecution bar before Amazon has seen  
 13 unredacted versions of the documents produced *in camera*, taken the Court ordered discovery, and  
 14 submitted briefing on remedies.

15 As Amazon has previously pointed out, Amazon has never seen the documents Eolas pro-  
 16 duced *in camera*. And even after Eolas complies with the Court’s order requiring production of  
 17 many of the *in camera* documents, Amazon will likely still not have seen the most critical *in cam-*  
 18 *era* documents. Further, because of the existence of the dispute over whether Eolas must produce  
 19 unredacted copies of the *in camera* documents to Amazon, Amazon has not been able to take the  
 20 discovery that Judge Tigar ordered. (*See*, Dkt. 403 at ¶¶ 4–11.) As a result, ruling on the merits of  
 21 the underlying dispute *before* Amazon has seen the documents and *before* Amazon has taken the  
 22 ordered discovery could seriously prejudice Amazon.

23 Amazon’s objection to any potential premature ruling on the merits is further supported by  
 24 Ninth Circuit law, which cautions against reliance on *in camera*, *ex parte* evidence in adjudicating  
 25 the merits. As Judge Koh noted in remanding part of Magistrate Grewal’s sanctions order in *Apple*,  
 26

---

27 <sup>1</sup> Counsel for Amazon has a conflicting hearing on February 1 and has reached out to counsel  
 28 for Eolas to request that the parties jointly propose that the Court reschedule the hearing for the  
 preceding week—January 25.

1 *Inc. v. Samsung Elecs. Co.*, Case No. 11-cv-01846-LHK(PSG), 2014 WL 4684842, at \*7 (Sept.  
 2 19, 2014), the Ninth Circuit has long held that while courts may use *in camera* review to make  
 3 determinations concerning scope of privilege, courts should not rely on materials produced only  
 4 *in camera* in reaching the merits of a dispute. “While approving *in camera* review for resolving  
 5 disputes over *access* to documents, the Ninth Circuit has cautioned against using such procedures  
 6 to resolve issues on the merits.” *Id.* (emphasis in original). Judge Koh went on to quote the Ninth  
 7 Circuit in *Meridian Int’l Logistics, Inc. v. United States*, as follows: “[T]his court has generally  
 8 recognized the capacity of a district judge to fashion and guide the procedures to be followed in  
 9 cases before him,’ [but] ‘in our judicial system adversary proceedings are the norm and *ex parte*  
 10 proceedings the exception.’” *Id.* (quoting, *Meridian Int’l Logistics, Inc. v. United States* 939 F.2d  
 11 740, 745 (9th Cir. 1991)). The rule eschewing reliance on *ex parte* evidence, like an *in camera*  
 12 review, to reach the merits of a dispute is widely followed.<sup>2</sup>

13 Therefore, Amazon respectfully provides notice that it objects to the extent that the Court  
 14 intends to reach the merits of the underlying dispute before Amazon has been given an opportunity  
 15 to review critical documents, take necessary discovery, and submit briefing on remedies.

---

18 <sup>2</sup> See, e.g., *Lynn v. Regents of the Univ. of Cal.*, 656 F.2d 1337, 1346 (9th Cir 1981) (“The re-  
 19 ceipt and review by the district court of the tenure review file for the purpose of assisting it to  
 20 make factual determinations or to evaluate other evidence violated principles of due process  
 21 upon which our judicial system depends to resolve disputes fairly and accurately.”); *Vining v.*  
 22 *Runyon*, 99 F.3d 1056, 1057 (11th Cir. 1996) (“Although a judge freely may use *in camera*, *ex*  
 23 *parte* examination of evidence to prevent the discovery or use of evidence, consideration of *in*  
 24 *camera* submissions to determine the merits of litigation is allowable only when the submissions  
 25 involve compelling national security concerns or the statute granting the cause of action specifi-  
 26 cally provides for *in camera* resolution of the dispute.”); *Abourezk v. Reagan*, 785 F.2d 1043,  
 27 1060–61 (D.C. Cir. 1986) (“We note our grave concern about the district court’s heavy reliance  
 28 upon *in camera ex parte* evidence when it granted the defendants’ motion for summary judg-  
 ment ... It is a hallmark of our adversary system that we safeguard party access to the evidence  
 tendered in support of a requested court judgment ... Exceptions to the main rule are both few  
 and tightly contained. Most notably, inspection of materials by a judge isolated in chambers may  
 occur when a party seeks to prevent use of the materials in the litigation ... If the court finds that  
 the claimed privilege does not apply, then the other side must be given access to the information;  
 if the court’s finding is that the privilege does apply, then the court may not rely upon the infor-  
 mation in reaching its judgment.”); *Ibrahim v. Dep’t of Homeland Sec.*, No. 06-cv-00545-WHA,  
 2012 WL 6652362, at \*3 (N.D. Cal. Dec. 20, 2012) (“[T]he judge may receive *ex parte* secret  
 communications for deciding ancillary matters, such as discovery privilege, but only in the rarest  
 of circumstances should the judge do so to resolve or to end a case.”).

DATED: January 8, 2018

Respectfully submitted,

By /s/ Richard G. Frenkel

DOUGLAS E. LUMISH, Bar No. 183863  
doug.lumish@lw.com  
RICHARD G. FRENKEL, Bar No. 204133  
rick.frenkel@lw.com  
JEFFREY G. HOMRIG, Bar No. 215890  
jeff.homrig@lw.com  
NICHOLAS YU, Bar No. 298768  
nicholas.yu@latham.com  
LATHAM & WATKINS LLP  
140 Scott Drive  
Menlo Park, CA 94025  
Telephone: (650) 328-4600  
Facsimile: (650) 463-2600

JOSEPH H. LEE, Bar No. 248046  
joseph.lee@lw.com  
LATHAM & WATKINS LLP  
650 Town Center Drive, 20th Floor  
Costa Mesa, CA 92626-1925  
Telephone: (714) 540-1235  
Facsimile: (714) 755-8290

AMIT MAKKER, Bar No. 280747  
amit.makker@lw.com  
LATHAM & WATKINS LLP  
505 Montgomery Street, Suite 2000  
San Francisco, CA 94111-6538  
Telephone: (415) 395-8034  
Facsimile: (415) 395-8095

MELISSA ARBUS SHERRY (pro hac vice)  
melissa.sherry@lw.com  
ELANA NIGHTINGALE DAWSON (pro hac vice)  
elana.nightingaledawson@lw.com  
LATHAM & WATKINS LLP  
555 Eleventh Street, Suite 1000  
Washington, DC 20004-1304  
Telephone: (202) 637-2200  
Facsimile: (202) 637-2201

JENNIFER H. DOAN (pro hac vice)  
jdoan@haltomdoan.com  
JOSHUA R. THANE (pro hac vice)  
jthane@haltomdoan.com  
J. RANDY ROESER (pro hac vice)  
rroeser@haltomdoan.com  
HALTOM & DOAN  
6500 Summerhill Road, Suite 1000  
Texarkana, TX 75503  
Telephone: (903) 255-1000

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

Facsimile: (903) 255-0800

GRANT KINSEL, Bar No. 172407  
gkinsel@perkinscoie.com  
PERKINS COIE, LLP  
1203 3rd Street, 39th Floor  
Seattle, WA 98112  
Telephone: (206)-395-316  
Facsimile: (206) 359-9000

*Counsel for Defendant*  
*AMAZON.COM, INC.*